

REMARKS

In the outstanding non-final Office Action¹ ("Office Action"), the Examiner (1) objected to a perceived informality in the Specification, (2) rejected claims 1, 3-18, 31, and 33-35 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, (3) rejected claims 1, 3-18, 31, and 33-35 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter the Applicant regards as the invention, and (4) rejected claims 1, 3-18, 31, and 33-35 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,513,260 to Ryan ("Ryan"), in view of U.S. Patent No. 5,629,980 to Stefik et al. ("*Stefik*"), and further in view of U.S. Patent No. 5,446,488 to Vogel ("*Vogel*").

Applicant proposes to amend claims 1 and 31. Support for these amendments may be found at least at page 31, lines 10-23 of the Applicant's Specification.

Below, Applicant respectfully traverses the above identified objections and rejections.

1. The Examiner's objection to the disclosure should be withdrawn in light of the following clarification

In the Office Action, the Examiner objected to the Applicant's disclosure because "the word 'hush' [was] used in numerous places in the drawings and written description," and "[i]t appear[ed] that Applicant intend[ed] 'hush' to mean 'hash.'" Office Action at page 2. Accordingly, the Examiner requested appropriate clarification. Although "hash"

functions are common in the art, a search of the Internet using any commonly available search engine reveals that “hush” functions also exist in the art. Applicant has therefore not mistakenly used the term ‘hush’ in place of the term ‘hash’ in the drawings and written description.

2. The Examiner’s rejection of claims 1, 3-18, 31, and 33-35 under 35 U.S.C. § 112, first paragraph, should be withdrawn

The Examiner rejected claims 1, 3-18, 31, and 33-35 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Office Action at page 3. Particularly, the Examiner stated that the element “examiner” was “not previously disclosed, nor could antecedent basis be found in the specification.” *Id.*

Established case law, however, makes it clear that there is no requirement that a claim term be repeated verbatim in the specification. Rather, claim limitations “must be supported in the specification through express, implicit, or inherent disclosure”. See MPEP 2161(I)(B) citing *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971). For example, when an explicit limitation in a claim “is not present in the written description... it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation.” See MPEP 2161(II)(A) citing *Hyatt v. Boone*, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998).

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

In this case, the element “examiner,” which replaced the phrase “examining means,” is implicitly present in Applicant’s specification because the specification states that “the examining means examines whether the content data to be distributed is content data of a first type..., examines whether the recording medium is a recording medium of a first type..., examines whether the reproducing apparatus is a reproducing apparatus of a first type..., and examines whether the recording apparatus is a recording apparatus of a first type...” Specification at page 4, line 10 - page 5, line 3. And one of ordinary skill in the art would understand that the term “examiner” likely refers to something with at least some ability to examine. Lastly, the Applicant’s specification also indicates that an embodiment of the examiner as claimed, the EMD system 1, “carries out the usage space examination in the apparatus and SAMs from following four viewpoints...” Specification at page 31, lines 21-23.

As the foregoing remarks establish that claims 1, 3-18, 31, and 33-35 comply with the written description requirement of 35 U.S.C. § 112, first paragraph, Applicant respectfully requests the withdrawal of the associated claim rejections.

3. The Examiner’s rejection of claims 1, 3-18, 31, and 33-35 under 35 U.S.C. § 112, second paragraph, should be withdrawn

The Examiner rejected claims 1, 3-18, 31, and 33-35 under 35 U.S.C. § 112, second paragraph, as being “indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” Office Action at page 3. Particularly, the Examiner contends that the claim term “examiner,” which

replaced the phrase “examining means,” would be “unclear to a person having ordinary skill in the art.” *Id.*

Applicant respectfully disagrees with the Examiner’s contentions, and as previously explained, draws the Examiner’s attention to Figure 1 as well as to Applicant’s specification at pages 31-32, where the Applicant has described at least one embodiment of the claim term “examiner.” Applicant also asserts that one of ordinary skill in the art would indeed understand an “examiner” as claimed to have the ability to examine, especially in light of the embodiments of the claim term “examiner” present in the written description.

Additionally, referring again to the “examiner” limitation, the Office Action states that “[a]lthough 35 U.S.C. 112, 6th paragraph is now clearly not invoked, it is still unclear in light of Applicant’s specification how many and what type of structures are required by this limitation.” Office Action at page 4. But given that the 6th paragraph of 35 U.S.C. § 112 is not invoked, Applicant is not obligated to make clear “how many and what type of structures” are required by any particular limitation. To the contrary, during prosecution, pending claims must be given their broadest reasonable interpretation consistent with the specification and “a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.” MPEP 2111(II) quoting *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004).

As the foregoing remarks establish that claims 1, 3-18, 31, and 33-35 comply with the requirements of 35 U.S.C. § 112, second paragraph, Applicant respectfully requests the withdrawal of the associated claim rejections.

4. The Examiner's rejection of claims 1, 3-18, 31, and 33-35 under 35 U.S.C. § 103(a) should be withdrawn

The Examiner rejected claims 1, 3-18, 31, and 33-35 under 35 U.S.C. § 103(a) as unpatentable over *Ryan* in view of *Stefik*", and further in view of *Vogel*. Applicant respectfully traverses these rejections. A *prima facie* case of obviousness has not been established.

Claim 1 recites a data distribution system including, for example:

a reproducing apparatus . . .
a recording apparatus . . .
an examiner . . .
a controller . . .

. . .

wherein the examiner:

...

examines the reproducing apparatus to determine whether the reproducing apparatus is of a first type for reproducing after the authentication processing or of a second type for reproducing without the processing, and

examines the recording apparatus to determine whether the recording apparatus is of a first type for recording after the authentication processing or of a second type for recording without the processing.

(emphasis added). The Examiner cited *Ryan*'s col. 3, line 63 - col. 4, line 11 as teaching several elements of claim 1, including the above identified elements. Office Action at page 7. But *Ryan* does not teach or suggest these claim elements.

Ryan discloses a CD player that looks for an authentication signature on the CD. See *Ryan* at col. 2, lines 65-67. If the authentication signature is present, the player will play the CD. If the authentication signature is not present, the player will not play the CD. See *Ryan* at col. 2, lines 32-44. The Examiner states that *Ryan* "discloses a

means for reproducing content (CD player), a recorder (CD-recorder) and means there between for examining and controlling transfer (black boxes).” Office Action at page 5.

According to col. 3, line 63 - col. 4, line 11 of *Ryan*, CDs to be copy-protected could contain “a special instruction to tell all CD-players to look for” an authenticating signature and refrain from playing CDs that do not contain such a signature. Such a “Look for An Authenticating Signature and Play Only If Found” instruction could be omitted from CDs which do not require copy-protecting. Therefore, copy-protection could be offered on a program by program basis. *Ryan’s* col. 3, line 63- col. 4, line 11 also reveals that the copy-protection offered by such a system could be compromised by “special black boxes connected in the single line between the CD-player and the CD-recorder.” Such black boxes could search for and remove the ‘Look For...’ instruction in the data stream from the CD-player so that the resulting illicit copies do not invoke the authenticating procedure in CD-players.

In alleging that *Ryan’s* col.3, line 63 - col. 4, line 11 discloses the claim limitation “wherein the examiner...examines the reproducing apparatus to determine whether the reproducing apparatus is of a first type for reproducing after the authentication processing or of a second type for reproducing without the processing,” the Office Action analogizes claim 1’s “examiner” to *Ryan’s* “black boxes.” See Office Action at page 15. But this analogy is flawed because nothing in *Ryan* suggests that a black box “examines the reproducing apparatus...”

Moreover, nothing in *Ryan* teaches or suggests examining reproducing apparatus to “determine whether the reproducing apparatus is of a first type for reproducing after the authentication processing or of a second type for reproducing”

without the processing." In *Ryan*, the CD player plays the contents of the CD. The CD player normally knows whether to play the contents based on the authenticating signature. As previously stated, a black box may successfully trigger the CD player to play an illicit copy. Regardless of whether the contents are authenticated or illicit, the CD player, which allegedly corresponds to the claimed "reproducing apparatus," is not examined to determine if it "is of a first type for reproducing after the authentication processing or of a second type for reproducing without the processing." There is no teaching or suggestion in *Ryan* that the CD player is examined.

Similarly, even assuming, *arguendo*, that the CD recorder in *Ryan* corresponds to the claimed "recording apparatus," Applicant finds no teaching or suggestion in *Ryan* that the CD recorder is examined to determine whether it "is of a first type for recording after the authentication processing or of a second type for recording without the processing," as further recited in claim 1. And, assuming, *arguendo*, that *Ryan's* black boxes are analogous to claim 1's "examiner," nothing in *Ryan* teaches or suggests the black boxes examining "the recording apparatus to determine whether the recording apparatus is of a first type...or of a second type..." Therefore *Ryan* does not teach or suggest the claim limitation "wherein the examiner...examines the recording apparatus to determine whether the recording apparatus is of a first type for recording after the authentication processing or of a second type for recording without the processing," as specified in claim 1.

As *Stefik* and *Vogel* do not make up for the deficiencies in *Ryan*, the cited references fail to teach or suggest "wherein the examiner...examines the reproducing apparatus to determine whether the reproducing apparatus is of a

first type for reproducing after the authentication processing or of a second type for reproducing without the processing, and examines the recording apparatus to determine whether the recording apparatus is of a first type for recording after the authentication processing or of a second type for recording without the processing," as recited in claim 1.

Additionally, the cited references, viewed separately or in combination, do not teach or suggest the following limitations of claim 1:

an examiner for examining usage space information of the content data, the first medium, the reproducing apparatus, the second medium, and the recording apparatus
...

wherein the usage space information indicates system information of the recording apparatus and the reproducing apparatus, ownership right information of the content data, format information of the content data, and distributing profit information obtained by the distribution of the content data...

(Emphasis Added).

The Office Action correctly states that *Ryan* does not disclose "wherein the usage space information indicates system information of the recording apparatus and the reproducing apparatus, ownership right information of the content data, format information of the content data, and distributing profit information obtained by the distribution of the content data," as recited in claim 1. Office Action at page 6.

However, the Office Action goes on to add that *Stefik* "in at least Figure 15 as well as in associated text does disclose the controlled copying of digital data in a digital rights management environment to include system information (items 1504, 1505, 1506), ownership rights information (items 1501 - 1503), format of digital data (item 1506), and profit distribution (items 1517-1525)." *Id.*

But even assuming, *arguendo*, that *Stefik*'s Figure 15 and associated text discloses usage space information indicating "system information of the recording apparatus and the reproducing apparatus, ownership right information of the content data, format information of the content data, and distributing profit information obtained by the distribution of the content data," neither *Stefik*, nor *Ryan*, viewed alone or in combination teaches or suggests, "an examiner for examining usage space information of the content data, the first medium, the reproducing apparatus, the second medium, and the recording apparatus ... wherein the usage space information indicates system information of the recording apparatus and the reproducing apparatus, ownership right information of the content data, format information of the content data, and distributing profit information obtained by the distribution of the content data," as is recited in claim 1. This is because neither reference teaches or suggests an examiner examining usage space information of the content data, the first medium, the reproducing apparatus, the second medium, and the recording apparatus. *Vogel* does not cure the deficiencies of *Ryan* and *Stefik*.

In the Response to Arguments section, the Office Action states that the black boxes in *Ryan*, Authorization Repository 202 or Master Repository 204 in *Stefik*, and broadcaster in *Vogel* disclose various examining means (examiners). Even assuming that these elements in the cited references may examine data, which Applicant does not concede, neither these elements nor any other elements in the cited references teach or suggest, however, the claimed combination: "an examiner for examining usage space information of the content data, the first medium, the reproducing apparatus, the second medium, and the recording apparatus...wherein the examiner: ... examines the

reproducing apparatus to determine whether the reproducing apparatus is of a first type for reproducing after the authentication processing or of a second type for reproducing without the processing, and examines the recording apparatus to determine whether the recording apparatus is of a first type for recording after the authentication processing or of a second type for recording without the processing," as recited in claim 1.

Accordingly, the references fail to establish a *prima facie* case of obviousness with respect to claim 1. Claims 3-18 depend from claim 1 and are thus also allowable over *Ryan*, *Stefik*, and *Vogel*, for at least the same reasons as claim 1. Independent claim 31, while of different scope, is also allowable over *Ryan*, *Stefik*, and *Vogel*. Claims 33-35 are also allowable at least due to their dependence from independent claim 31.

In view of the foregoing remarks, Applicant respectfully requests reconsideration of the application and withdrawal of the rejections. Claims 1, 3-18, 31, and 33-35 are in condition for allowance, and Applicant requests a favorable action. Applicant also submits that the entry of this amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: September 14, 2009

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